



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Lackey, George C. ) Art Unit: 3641  
)  
Application No. 10/631,230 ) Examiner: Michelle (Shelley) Clement  
)  
Filed: July 31, 2003 )  
)  
For: *Apparatus and Method for Supporting* )  
*A Firearm* )  
)  
Attorney Docket No. 74123-001 )

St. Louis, Missouri 63105-3441  
November 22, 2005

Honorable Commissioner of  
Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

SECOND AMENDED APPEAL BRIEF

In response to the Notice of Non-Compliant Appeal Brief dated February 13, 2006,  
Applicant submits the following amended appeal brief. Applicant has addressed the issue raised  
in the Notice and has not added any new subject matter in this amended appeal brief.

It is not believed that extensions of time or payment of additional fees are required.  
However, in the event that any extensions of time or additional fees are necessary to prevent  
abandonment of this application, then such extensions of time are hereby petitioned for, and any  
fees required are hereby authorized to be charged to Deposit Account 08-3460.

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**Real Party In Interest**

The real party in interest is the party named in the caption of this brief and identified as the applicant of record, George C. Lackey.



### **Related Appeals And Interferences**

No other appeals or interferences affect this application.

## **Status Of Claims**

Claims 1-13 are currently pending in the application. Claims 3 and 7 are subject to a restriction requirement issued by the Examiner, and examination of these two claims is dependent on the allowance of an identified generic claim upon which those claims depend. The Examiner has acknowledged that claims 1, 4, 5, and 8-12 are generic. Claims 3 and 7 are withdrawn pending allowance of an identified generic claim upon which claims 3 and 7 depend. Original claims 14 and 15 were also subject to the same restriction requirement and have been cancelled by Applicant. Claims 1, 2, 4-6, and 8-13 stand rejected in their present form, *i.e.*, after the amendment and response dated October 15, 2004.<sup>1</sup> Claims 1, 2, 4-6, and 8-13 are the claims appealed.

Claim 1 (Rejected). The rejection of Claim 1 is appealed by Applicant.

Claim 2 (Rejected). The rejection of Claim 2 is appealed by Applicant.

Claim 3 (Withdrawn)

Claim 4 (Rejected). The rejection of Claim 4 is appealed by Applicant.

Claim 5 (Rejected). The rejection of Claim 5 is appealed by Applicant.

Claim 6 (Rejected). The rejection of Claim 6 is appealed by Applicant.

Claim 7 (Withdrawn)

Claim 8 (Rejected). The rejection of Claim 8 is appealed by Applicant.

Claim 9 (Rejected). The rejection of Claim 9 is appealed by Applicant.

Claim 10 (Rejected). The rejection of Claim 10 is appealed by Applicant.

Claim 11 (Rejected). The rejection of Claim 11 is appealed by Applicant.

Claim 12 (Rejected). The rejection of Claim 12 is appealed by Applicant.

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<sup>1</sup> The amendment to claim 1 and cancellation of claims 14 and 15 were resubmitted on January 6, 2005 in response to a notice of non-compliant response.

Claim 13 (Rejected). The rejection of Claim 13 is appealed by applicant.

Claim 14 (Cancelled)

Claim 15 (Cancelled)

A copy of the claims involved in the appeal is attached in the Claims Appendix.

### **Status Of Amendments**

Claim 1 was amended and claims 14 and 15 cancelled in a response filed on October 15, 2004, to the Examiner's First Office Action.<sup>2</sup> The Examiner entered a Final Office Action on April 22, 2005. Applicant has not submitted any amendments to the claims subsequent to the Examiner's Final Office Action. Applicant filed his notice of appeal on June 22, 2005.

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<sup>2</sup> See n. 1 above.

### **Summary Of The Claimed Subject Matter**

Independent claim 1, the only independent claim involved in this appeal and remaining in the application is directed to a novel portable gun rest that may be easily carried, works with shafts of varying diameters and lengths, including walking sticks, and provides a stable and generally horizontal support for a firearm. *See* Specification, p. 3, lines 22 through 26. In addition, the gun rest may be positively fixed in a position on a particular shaft or stick yet also readily adjusted to various heights along the entire length of the shaft, all while providing a firm, stable, horizontal support surface for the user's firearm. *See* Specification, p. 3, lines 25 through 26; p. 4, lines 1 through 3. The gun rest includes:

- an elongated support member (14; Figs. 2, 3, and 4) having a clamping surface (28, 30; Figs. 2 and 3) and a firearm supporting surface (38; Figs. 2 and 3), *see* Specification, p. 6, lines 6-11; p. 8, lines 4-5;
- a collar (20; Figs. 2, and 4) connected with the elongated support member, *see* Specification, p. 6, line 6 and 15-24; and
- an adjustable mechanism (16, 18; Figs. 2, 3, and 4) connecting the collar with the elongated support member and adjusting the position of the collar relative to the clamping surface of the support member, the collar and clamping surface securing the support member to a shaft (12; Figs. 1, 2, and 3), *see* Specification, p. 6, line 25 to p. 7, line 23.



### **Grounds Of Rejection To Be Reviewed On Appeal**

- 1) Whether amended claim 1 and original claims 2 and 6 are anticipated by, under 35 U.S.C. §102(b), or, in the alternative, obvious, under 35 U.S.C. §103(a), over U.S. Patent No. 3,302,497 to Paden (the “‘497 patent”).
- 2) Whether Claims 4, 5, and 8-10 are unpatentable under 35 U.S.C. §103 over the ‘497 patent in view of U.S. Patent No. 5,829,099 to Kopelman et al. (the “‘099 patent”).
- 3) Whether Claims 11 and 12 are unpatentable under 35 U.S.C. §103 over the ‘497 patent in view of U.S. Patent No. 3,805,646 to Knight (the “‘646 patent”).
- 4) Whether Claims 1 and 13 are unpatentable under 35 U.S.C. §103 over European Patent No. EP 618045 to Scholl et al. (the “Scholl patent”).

## **Argument**

### **I. History Of Application**

In the First Office Action, dated July 16, 2004, the Examiner rejected original claims 1, 2, 4-6, and 8-11 under 35 U.S.C. §102(e) as anticipated by U.S. patent No. 6,588,637 to Gates et al. (the “‘637 patent”). Claim 12 was rejected under 35 U.S.C. §103 as being unpatentable over the ‘637 patent. Finally, claims 1, 2, 4-6, 8-11, and 13 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,531,643 to Bradley (the “‘643 patent”) and U.S. Patent No. 1,090,929 to McFaddin (the “‘929 patent”). Applicant responded to the First Office Action by amending claim 1<sup>3</sup>.

In the Final Office Action, the Examiner noted consideration of Applicant’s amendments in response to the Office Action of July 16, 2004, but concluded that those amendments were rendered moot in view of new grounds of rejection. The Examiner then rejected amended claim 1 and original claims 2 and 6 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over the ‘497 patent. Claims 4, 5, and 8-10 were rejected under 35 U.S.C. §103 as being unpatentable over the ‘497 patent in view of the ‘099 patent. Claims 11 and 12 were rejected under 35 U.S.C. §103 as being unpatentable over the ‘497 patent

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<sup>3</sup> Claim 1 was amended as follows:

1. A firearm supporting apparatus suitable for use with shafts of varying diameters and lengths, including:

an elongated support member having an end surface and a top surface, wherein said end surface further comprises a clamping surface and said top surface further comprises a firearm supporting surface and said clamping surface and said firearm supporting surface are integral with the elongated support member;

a collar connected with the elongated support member; and

an adjustable mechanism connecting the collar with the elongated support member and adjusting the position of the collar relative to the clamping surface of the support member, resulting in movement of the collar relative to the clamping surface in a direction parallel to the elongated support member, the collar and clamping surface securing the support member to the shaft.

in view of the '646 patent. Claims 1 and 13 were rejected under 35 U.S.C. §103 as being unpatentable over the Scholl patent. The Examiner concluded that Applicant's amendments in response to the Office Action of July 16, 2004 necessitated the new grounds of rejection presented in the Final Office Action.<sup>4</sup>

## **II. Arguments Relating To Each Appealed Ground Of Rejection**

### **A. *Rejection Of Amended Claim 1 And Original Claims 2 And 6 As Anticipated By, Under 35 U.S.C. §102(b), Or, In The Alternative, Obvious, Under 35 U.S.C. §103, Over U.S. Patent No. 3,302,497 To Paden (The "497 Patent").***

In the Final Office Action, dated April 22, 2005, the Examiner rejected amended claim 1 and original claims 2 and 6 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,302,497 to Paden (the "497 patent"). First, the stated rejection under 35 U.S.C. §102(b) is inappropriate as to each of claims 1, 2, and 6 because the '497 patent lacks an express limitation of independent claim 1, upon which claims 2 and 6 depend, namely that "said clamping surface and said firearm supporting surface are integral with the elongated support member." The Examiner acknowledges this obvious shortcoming of the '497 patent at page 3 of the Final Office Action. Second, the '497 patent represents non-analogous art, as is the case with the other prior art references cited by the Examiner in the Final Office Action. Finally, the pipe wrench of the '497 patent lacks a

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<sup>4</sup> While not generally presented as a ground for appeal, Applicant also respectfully submits that that the issuance of the Final Office Action in this matter was premature. In response to the First Office Action, Applicant amended only original claim 1. The amendments made to claim 1 made no significant change to either the nature or scope of claim 1. Furthermore, the amendments did not add or remove limitations but, rather, clarified the physical relationship among the "elongated support member," "clamping surface," and "firearm supporting surface" limitations and the manner in which the "adjustable mechanism" moved the "collar." These limitations were each included in original claim 1. In contrast to the limited nature of Applicant's amendments to claim 1, the prior art references upon which the rejections within the Final Office Action were based represented a significant departure from the prior art references cited in the First Office Action. Therefore, Applicant respectfully requests that the Examiner reconsider the finality of the Final Office Action.

clamping surface that includes upper and lower support arms and a collar slot separating the upper and lower support arms as required by claim 6.

**1. The Rejection of Claims 1, 2, and 6 Under 35 U.S.C. §102(b) Based On The '497 Patent In The Final Office Action Was Improper**

***Claims 1, 2, and 6***

In the Final Office Action, the Examiner rejected amended claim 1 and original claims 2 and 6 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over '497 patent. The stated ground of rejection under 35 U.S.C. §102(b) is improper because the '497 patent lacks an express limitation of independent claim 1, upon which claims 2 and 6 depend, namely that "said clamping surface and said firearm supporting surface are integral with the elongated support member."

The unequivocal view of the Federal Circuit is that a single reference must teach, *i.e.*, identically describe each and every element of the rejected claim for a proper rejection under 35 U.S.C. § 102. *See Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 U.S.P.Q. 409 (Fed. Cir. 1984). Claim 1, upon which claims 2 and 6 depend, includes the express limitation that "said clamping surface and said firearm supporting surface are integral with the elongated support member." The Examiner expressly acknowledged at page 3 of the Final Office Action that the '497 patent does not describe this limitation: " ... [the '497 patent] does not expressly disclose the clamping surface and the supporting surface being integral with the elongated support member." Therefore, the '497 patent does not teach each and every element of claim 1 and cannot support a proper rejection under 35 U.S.C. §102.

## **2. The '497 Patent Cited In The Rejection Of Claims 1, 2, and 6 Is Non-Analogous Art**

### ***Claims 1, 2, and 6***

The '497 patent is directed to a hand tool, specifically, a chain wrench. Applicant respectfully submits that this prior art reference is drawn to non-analogous art and, therefore, cannot properly support an obviousness rejection of Applicant's claims 1, 2, and 6.

The proper initial factual determination in assessing obviousness of a claimed invention is to identify the scope and content of the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 693-94, 15 L.Ed.2d 545, 148 U.S. P.Q. 459, 467 (1966). The field of the inventor's endeavor and the particular problem with which the inventor was involved are examined to ascertain the proper scope of the prior art. *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881, 45 U.S.P.Q.2d 1977, 1981 (Fed. Cir. 1998). The application identifies the field of Applicant's endeavor as firearm accessories. Specification, p. 1, line 4. The particular problem with which Applicant was involved was the development of a portable gun rest that could be used with shafts or sticks of varying dimensions and provides a stable horizontal support surface. Specification, p. 3, lines 15-17.

The determination of whether a reference is from a non-analogous art similarly focuses on two questions: (1) whether the reference is within the field of the inventor's endeavor and, if not, (2) whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986). As identified above, Applicant's field of endeavor is the area of firearm accessories. The particular problem that Applicant was addressing was providing a portable and stable horizontal support surface from which a hunter could fire a firearm that could be used with vertical supports of almost any dimension.

It is clear that the '497 patent is not within the field of Applicant's endeavor. The '497 patent is directed to a hand tool, specifically, a chain based wrench for pipes. Hand tools, and, in particular, pipe wrenches, have no relation whatsoever to firearms, firearm accessories, or hunting. Therefore, it simply cannot be said that these items are within the field of Applicant's endeavor.

Furthermore, the '497 patent is not reasonably pertinent to the particular problem being addressed by Applicant. Applicant's efforts were directed to providing a portable and stable horizontal support surface for a firearm that can be used with almost any vertical support means. As a practical matter, the key issue in solving this problem is providing a readily adjustable means for attaching the support surface to the vertical support while minimizing or eliminating any deflection or other vertical movement of the support surface, relative to the vertical support, upon the application of a downward force, namely the weight of the firearm.

In contrast, the purpose and function of the chain wrench of the '497 patent is to provide a means by which a user may impart a torsional force upon an object, specifically, a pipe. The '497 patent does not speak at all to the key issue of providing a horizontal support surface and eliminating vertical deflection of that surface when a downward force is introduced. Response to vertical forces introduced on a handle of a wrench is simply not a consideration in pipe or oil filter wrench design. Therefore, it cannot be said that these patents are pertinent to the particular problem addressed by Applicant.

Furthermore, there is no suggestion or motivation contained within the '497 patent leading one of ordinary skill in the art to use the device disclosed therein. Applicant respectfully submits that the citation of this reference may represent the application of hindsight based on the teaching of the present application, which is a practice that the Federal Circuit has counseled

against. *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992) (“The combination of elements from non-analogous sources, in a manner that reconstructs Applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant’s invention itself.”).

As further support for the conclusion that the ‘497 patent is drawn to a non-analogous art, Applicant notes that hand tools<sup>5</sup> are classified in a completely different class than are firearm accessories, such as gun rests<sup>6</sup>. The distinct and separate classification of the ‘497 patent is additional evidence that cited reference is neither related nor pertinent to Applicant’s claimed invention.

**3. The ‘497 Patent Does Not Disclose Or Suggest A Clamping Surface That Includes Upper And Lower Support Arms And A Collar Slot Separating The Upper And Lower Support Arms As Required By Claim 6**

***Claim 6***

In rejecting claim 6 as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over the ‘497 patent, the Examiner asserts that the ‘497 patent teaches a clamping surface that includes upper and lower support arms and defines a collar slot separating the upper and lower support arms. Final Office Action, p. 3. This limitation is introduced in claim 6.

Applicant respectfully submits that the ‘497 patent does not in fact teach separate support arms and a collar slot. Instead, the ‘497 patent describes a single jaw (90) that has a gripping surface (96) having teeth (98). There is no reference anywhere within the ‘497 patent to any

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<sup>5</sup> The primary classification for the ‘497 patent is U.S. Class 81 – Hand Tools.

<sup>6</sup> U.S. Class 42/Subclass 94 is the appropriate classification for gun rests.

structure like the clamping surface of claim 6 with upper and lower support arms and a collar slot. Therefore, the '497 patent neither describes nor suggests in any manner an express limitation of claim 6 and does not support either the stated §102(b) or §103 rejections of claim 6 advanced in the Final Office Action.

**B. *Rejection of Claims 4, 5, And 8-10 As Unpatentable Under 35 U.S.C. §103 Over The '497 Patent In View Of U.S. Patent No. 5,829,099 To Kopelman et al. (The "'099 Patent").***

***Claims 4, 5, and 8-10***

Claims 4, 5, and 8-10 were rejected under 35 U.S.C. §103 as being unpatentable over the '497 patent in view of U.S. Patent No. 5,829,099 to Kopelman et al. (the "'099 patent"). Claims 4, 5, and 8-10 depend from independent claim 1. The '497 patent is directed to a hand tool, specifically, a chain wrench. The '099 patent is directed to a universal ergonomic handle. Applicant respectfully submits that these prior art references are drawn to non-analogous art and, therefore, cannot properly support an obviousness rejection of Applicant's claims 4, 5, and 8-10.

The proper initial factual determination in assessing obviousness of a claimed invention is to identify the scope and content of the prior art. *Graham*, 383 U.S. at 17-18, 86 S.Ct. at 693-94, 15 L.Ed.2d 545, 148 U.S. P.Q. at 467. The field of the inventor's endeavor and the particular problem with which the inventor was involved are examined to ascertain the proper scope of the prior art. *Monarch Knitting*, 139 F.3d at 881, 45 U.S.P.Q.2d at 1981. The application identifies the field of Applicant's endeavor as firearm accessories. Specification, p. 1, line 4. The particular problem with which Applicant was involved was the development of a portable gun rest that could be used with shafts or sticks of varying dimensions and provides a stable horizontal support surface. Specification, p. 3, lines 15-17.



The determination of whether a reference is from a non-analogous art similarly focuses on two questions: (1) whether the reference is within the field of the inventor's endeavor and, if not, (2) whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Deminski*, 796 F.2d at 442, 230 U.S.P.Q. at 315. As identified above, Applicant's field of endeavor is the area of firearm accessories. The particular problem that Applicant was addressing was providing a portable and stable horizontal support surface from which a hunter could fire a firearm that could be used with vertical supports of almost any dimension.

It is clear that the '497 and '099 patents are not within the field of Applicant's endeavor. The '497 patent is directed to a hand tool, specifically, a chain based wrench for pipes. The '099 patent is directed to a universal ergonomic handle for hand and power tools. '099 Patent, column 1, line 52 to column 2, line 12. Hand tools, and, in particular, pipe wrenches, have no relation whatsoever to firearms, firearm accessories, or hunting. Therefore, it simply cannot be said that these items are within the field of Applicant's endeavor.

Furthermore, the '497 and '099 patents are not reasonably pertinent to the particular problem being addressed by Applicant. Applicant's efforts were directed to providing a portable and stable horizontal support surface for a firearm that can be used with almost any vertical support means. As a practical manner, the key issue in solving this problem is providing a readily adjustable means for attaching the support surface to the vertical support while minimizing or eliminating any deflection or other vertical movement of the support surface, relative to the vertical support, upon the application of a downward force, namely the weight of the firearm.

In contrast, the purpose and function of the chain and strap wrench of the '497 patent is to provide a means by which a user may impart a torsional force upon an object, specifically, a pipe. The '497 patent does not speak at all to the key issue of providing a horizontal support surface and eliminating vertical deflection of that surface when a downward force is introduced. Response to vertical forces introduced on a handle of a wrench is simply not a consideration in pipe wrench design. The '099 patent is directed only to the issue of preventing repetitive motion injuries arising from the use of hand tools. Applicant's claimed invention does not possess or require a handle, and, as such, repetitive motion injuries were not a relevant concern in its development. Therefore, it cannot be said that these patents are pertinent to the particular problem addressed by Applicant.

Furthermore, there is no suggestion or motivation contained within the cited references leading one of ordinary skill in the art to use and combine these references. Applicant respectfully submits that the citation of these references may represent the application of hindsight based on the teaching of the present application, which is a practice that the Federal Circuit has counseled against. *In re Oetiker*, 977 F.2d at 1447, 24 U.S.P.Q.2d at 1446 ("The combination of elements from non-analogous sources, in a manner that reconstructs Applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.").

As further support for the conclusion that the references cited in the Final Office Action are drawn to a non-analogous art, Applicant notes that hand tools<sup>7</sup> are classified in a completely

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<sup>7</sup> The primary classification for the '497 patent is U.S. Class 81 – Hand Tools. The primary classification for the '099 patent is U.S. Class 16 – Miscellaneous Hardware.

different class than are firearm accessories, such as gun rests<sup>8</sup>. The distinct and separate classification of these items is additional evidence that cited references are neither related nor pertinent to Applicant's claimed invention.

**C. *Rejection of Claims 11 And 12 As Unpatentable Under 35 U.S.C. §103 Over The '497 Patent In View Of U.S. Patent No. 3,805,646 To Knight (The "646 Patent").***

***Claims 11 and 12***

Claims 11 and 12 were rejected under 35 U.S.C. §103 as being unpatentable over the '497 patent in view of U.S. Patent No. 3,805,646 to Knight (the "'646 patent"). Claims 11 and 12 depend from independent claim 1. The '497 and '646 patents are directed to hand tools, specifically, chain wrenches. Applicant respectfully submits that these prior art references are drawn to non-analogous art and, therefore, cannot properly support an obviousness rejection of Applicant's claims 11 and 12.

The proper initial factual determination in assessing obviousness of a claimed invention is to identify the scope and content of the prior art. *Graham*, 383 U.S. at 17-18, 86 S.Ct. at 693-94, 15 L.Ed.2d 545, 148 U.S. P.Q. at 467. The field of the inventor's endeavor and the particular problem with which the inventor was involved are examined to ascertain the proper scope of the prior art. *Monarch Knitting*, 139 F.3d at 881, 45 U.S.P.Q.2d at 1981. The application identifies the field of Applicant's endeavor as firearm accessories. Specification, p. 1, line 4. The particular problem with which Applicant was involved was the development of a portable gun rest that could be used with shafts or sticks of varying dimensions and provides a stable horizontal support surface. Specification, p. 3, lines 15-17.

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<sup>8</sup> U.S. Class 42/Subclass 94 is the appropriate classification for gun rests.

The determination of whether a reference is from a non-analogous art similarly focuses on two questions: (1) whether the reference is within the field of the inventor's endeavor and, if not, (2) whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Deminski*, 796 F.2d at 442, 230 U.S.P.Q. at 315. As identified above, Applicant's field of endeavor is the area of firearm accessories. The particular problem that Applicant was addressing was providing a portable and stable horizontal support surface from which a hunter could fire a firearm that could be used with vertical supports of almost any dimension.

It is clear that the '497 and '646 patents are not within the field of Applicant's endeavor. The '497 and '646 patents are directed to hand tools, specifically, chain based wrenches for pipes. Hand tools, and, in particular, pipe wrenches, have no relation whatsoever to firearms, firearm accessories, or hunting. Therefore, it simply cannot be said that these items are within the field of Applicant's endeavor.

Furthermore, these references are not reasonably pertinent to the particular problem being addressed by Applicant. Applicant's efforts were directed to providing a portable and stable horizontal support surface for a firearm that can be used with almost any vertical support means. As a practical matter, the key issue in solving this problem is providing a readily adjustable means for attaching the support surface to the vertical support while minimizing or eliminating any deflection or other vertical movement of the support surface, relative to the vertical support, upon the application of a downward force, namely the weight of the firearm.

In contrast, the purpose and function of the chain wrenches of the '497 and '646 patents is to provide a means by which a user may impart a torsional force upon an object, specifically, a pipe. These references do not speak at all to the key issue of providing a horizontal support

surface and eliminating vertical deflection of that surface when a downward force is introduced. Response to vertical forces introduced on a handle of a wrench is simply not a consideration in pipe or oil filter wrench design. Therefore, it cannot be said that these patents are pertinent to the particular problem addressed by Applicant.

Furthermore, there is no suggestion or motivation contained within the cited references leading one of ordinary skill in the art to use and combine these references. Applicant respectfully submits that the citation of these references may represent the application of hindsight based on the teaching of the present application, which is a practice that the Federal Circuit has counseled against. *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992) (“The combination of elements from non-analogous sources, in a manner that reconstructs Applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant’s invention itself.”).

As further support for the conclusion that the references cited in the Final Office Action are drawn to a non-analogous art, Applicant notes that hand tools<sup>9</sup> are classified in a completely different class than are firearm accessories, such as gun rests<sup>10</sup>. The distinct and separate classification of these items is additional evidence that cited references are neither related nor pertinent to Applicant’s claimed invention.

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<sup>9</sup> The primary classification for the ‘497 and ‘646 references is U.S. Class 81 – Hand Tools.

<sup>10</sup> U.S. Class 42/Subclass 94 is the appropriate classification for gun rests.

**D.     *Rejection of Claims 1 And 13 As Unpatentable Under 35 U.S.C. §103 Over European Patent No. EP 618045 To Scholl Et Al. (The “Scholl Patent”).***

Claims 1 and 13 were rejected under 35 U.S.C. §103 as being unpatentable over European Patent No. EP 618045 to Scholl et al. (the “Scholl patent”). First, the Scholl patent, which discloses a strap wrench for removal of automobile oil filters, represents non-analogous art. Second, with respect to claim 13, the Scholl patent lacks “a set of collars of varying diameters.” It would not have been obvious to provide straps of varying lengths for the strap wrench of the Scholl patent because it is expressly designed to accommodate a specific type of object, automobile oil filters, and the known variances of those filters without the need to change straps.

**1.     The Scholl Patent Cited In The Rejection Of Claims 1 and 13 Is Non-Analogous**

***Claims 1 and 13***

The Scholl patent is directed to a hand tool, specifically, an oil filter wrench. Applicant respectfully submits that this prior art reference is drawn to non-analogous art and, therefore, cannot properly support an obviousness rejection of Applicant’s claims 1 and 13.

The proper initial factual determination in assessing obviousness of a claimed invention is to identify the scope and content of the prior art. *Graham*, 383 U.S. at 17-18, 86 S.Ct. at 693-94, 15 L.Ed.2d 545, 148 U.S. P.Q. at 467. The field of the inventor’s endeavor and the particular problem with which the inventor was involved are examined to ascertain the proper scope of the prior art. *Monarch Knitting*, 139 F.3d at 881, 45 U.S.P.Q.2d at 1981. The application identifies the field of Applicant’s endeavor as firearm accessories. Specification, p. 1, line 4. The particular problem with which Applicant was involved was the development of a portable gun

rest that could be used with shafts or sticks of varying dimensions and provides a stable horizontal support surface. Specification, p. 3, lines 15-17.

The determination of whether a reference is from a non-analogous art similarly focuses on two questions: (1) whether the reference is within the field of the inventor's endeavor and, if not, (2) whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Deminski*, 796 F.2d at 442, 230 U.S.P.Q. at 315. As identified above, Applicant's field of endeavor is the area of firearm accessories. The particular problem that Applicant was addressing was providing a portable and stable horizontal support surface from which a hunter could fire a firearm that could be used with vertical supports of almost any dimension.

It is clear that the Scholl patent is not within the field of Applicant's endeavor. The Scholl patent is directed to a hand tool, specifically, a strap based wrench for automobile oil filters. Hand tools, and, in particular, oil filter wrenches, have no relation whatsoever to firearms, firearm accessories, or hunting. Therefore, it simply cannot be said that these items are within the field of Applicant's endeavor.

Furthermore, the Scholl patent is not reasonably pertinent to the particular problem being addressed by Applicant. Applicant's efforts were directed to providing a portable and stable horizontal support surface for a firearm that can be used with almost any vertical support means. As a practical matter, the key issue in solving this problem is providing a readily adjustable means for attaching the support surface to the vertical support while minimizing or eliminating any deflection or other vertical movement of the support surface, relative to the vertical support, upon the application of a downward force, namely the weight of the firearm.

In contrast, the purpose and function of the strap wrenches of the Scholl patent is to provide a means by which a user may impart a torsional force upon an oil filter. The Scholl patent does not speak at all to the key issue of providing a horizontal support surface and eliminating vertical deflection of that surface when a downward force is introduced. Response to vertical forces introduced on a handle of a wrench is simply not a consideration in oil filter wrench design. Therefore, it cannot be said that the Scholl patent is pertinent to the particular problem addressed by Applicant.

Furthermore, there is no suggestion or motivation contained within the Scholl patent leading one of ordinary skill in the art to use this reference. Applicant respectfully submits that the citation of the Scholl patent may represent the application of hindsight based on the teaching of the present application, which is a practice that the Federal Circuit has counseled against. *In re Oetiker*, 977 F.2d at 1447, 24 U.S.P.Q.2d at 1446 (“The combination of elements from non-analogous sources, in a manner that reconstructs Applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant’s invention itself.”).

As further support for the conclusion that the Scholl patent is drawn to a non-analogous art, Applicant notes again that hand tools are classified in a completely different class than are firearm accessories, such as gun rests. The distinct and separate classification of these items is additional evidence that cited references are neither related nor pertinent to Applicant’s claimed invention.



**2. The Scholl Patent Does Not Disclose Or Suggest A Set Of Collars Of Varying Diameters As Required By Claim 13.**

***Claim 13***

Claim 13 introduces a limitation of “a set of collars of varying diameters and wherein the collar is selected from the set based on a diameter of the shaft.” The Scholl patent discloses a strap-based wrench for the removal of automotive oil filters. As indicated in Fig. 10 of the Scholl patent, the strap of the wrench is designed with an adjustment means to increase and decrease the diameter of the strap. Clearly the design described in the Scholl patent is intended to provide flexibility of use by varying the diameter of the strap, not by exchanging straps.

It would not have been obvious to provide straps of varying lengths for the strap wrench of the Scholl patent because it is expressly designed to accommodate a specific type of object, automobile oil filters, and the known variances of those filters, by adjustment of the strap itself, not replacement of the strap. Indeed, replacing the strap defeats the very purpose of the design described in the Scholl patent and changes its principle of operation, which is not a permissible modification of a prior art reference. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Therefore, Applicant respectfully submits that the Scholl patent does not render obvious the use of a set of collars of varying diameters as described in claim 13.

## **Conclusion**

The rejections under 35 U.S.C. §§ 102(b) and 103 advanced in the Final Office Action are contrary to law. Accordingly, it is submitted that the rejections are improper and Applicant prays for a finding in his favor.

Respectfully submitted,



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## **CLAIMS APPENDIX**

1. A firearm supporting apparatus suitable for use with shafts of varying diameters and lengths, including:

an elongated support member having an end surface and a top surface, wherein said end surface further comprises a clamping surface and said top surface further comprises a firearm supporting surface and said clamping surface and said firearm supporting surface are integral with the elongated support member;

a collar connected with the elongated support member; and

an adjustable mechanism connecting the collar with the elongated support member and adjusting the position of the collar relative to the clamping surface of the support member, resulting in movement of the collar relative to the clamping surface in a direction parallel to the elongated support member, the collar and clamping surface securing the support member to the shaft.

2. The firearm supporting apparatus as set forth in claim 1, wherein the adjustable mechanism includes an elongated threaded member connected with the collar and the elongated support member and a fastening device associated with the threaded member, wherein tightening and loosening the fastening device on the threaded member adjusts the position of the collar relative to the clamping surface.

3. (Not Appealed)

4. The firearm supporting apparatus as set forth in claim 1, wherein the firearm supporting surface is contoured.

5. The firearm supporting apparatus as set forth in claim 4, wherein the firearm supporting surface is a concave cradle.

6. The firearm supporting apparatus as set forth in claim 2, wherein the clamping surface includes upper and lower support arms and wherein the support member defines a collar slot separating said upper and lower support arms.

7. (Not Appealed)

8. The firearm supporting apparatus as set forth in claim 1, further including a flexible material covering a portion of the elongated support member.

9. The firearm supporting apparatus as set forth in claim 1, wherein at least the firearm supporting surface is covered by a flexible material.

10. The firearm supporting apparatus as set forth in claim 9, wherein the flexible material is provided with a non-skid surface.

11. The firearm supporting apparatus as set forth in claim 1, wherein the clamping surface is concave.

12. The firearm supporting apparatus as set forth in claim 1, wherein the clamping surface is covered by a flexible material.

13. A firearm supporting apparatus as set forth in claim 1, further including a set of collars of varying diameters and wherein the collar is selected from the set based on a diameter of the shaft.

14. (Not Appealed)

15. (Not Appealed)

## **EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

None.



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